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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,456	09/18/2003	David J. Payne	08049.0932	7290
22852	7590	05/07/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PHAN, MAN U	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 05/07/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/665,456

Applicant(s)

PAYNE ET AL.

Examiner

Man Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/30/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. The application of Payne et al. for the "Providing a corrected delivery address" filed 09/18/2003 has been examined. This application claims priority from provisional application 60/412,030 filed 09/20/2002. Claims 1-48 are pending in the application.
2. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks <sup>TM</sup>, and other legal symbols @, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 25-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically, as directed to "computer program product" or "a software routine". The claimed "computer readable medium" product or "software routine" of claims 25-36 is non-statutory as at no time in the claim does applicant define the software

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routine. A computer program per se is not in one of the statutory categories. A computer program must be claimed in combination with an appropriate computer readable medium so that the program is capable of producing a useful, concrete and tangible result when used in a computer system

Claims 25-36 are directed to “a computer readable medium” product which is not supported by either a specific asserted utility or a well established utility. Claims 25-36 merely defines “*a computer readable medium product*” or “*data record for storing instructions*”, and is not directed to statutory subject matter. The claims appear to be nothing more than a signal not tangibly embodied in a manner so as to be executable and thus non-statutory for failing to be in one of the categories of invention. It’s not tangibly embodies and non-functional descriptive material - data per se. Therefore, what applicant is attempting to claim as a computer program product or data record as is known in the art. The claim is actually drawn to non-functional descriptive material stored on a machine readable medium. The description given in the specification does not cure this problem. In practical terms, claims define non-statutory processes if they simply manipulate abstract ideas, e.g., a bid or a bubble hierarchy, without some claimed practical application, Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59; Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759.

5. Claims 25-36 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-24 and 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (US#5,422,821) in view of Anchor Computer "NCOA" (Anchorcomputer.com).

With respect to claims 13-14, 20-22 and 37-38, 44-46, the references disclose a novel system and method for the carriers to efficiently provide corrected delivery address data services, according to the essential features of the claims. Allen et al. (US#5,422,821) discloses in Fig. 2 a plan view diagram of the USPS mail-piece processing system. Allen teaches saving a resolved address, the address being resolved by at least one of a plurality of address resolution processes

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(see Col. 8 lines 5-14 and Col. 2 lines 57-67, Examiner is interpreting stored information in the database as having been saved). Examiner is further interpreting a National Change of Address (NCOA) database as an address resolution process; the resolved address including a correct address record and an incorrect address record (see Col. 7 lines 1-10 and Col. 2 lines 57-67 and Col. 6 lines 35-41). However, Allen does not explicitly teach receiving a first unresolved address and determining if the first unresolved address matches the incorrect address record of the resolved address. In the same field of endeavor, Anchor teaches, using its United States Postal Service approved address-matching software, processes your lists and makes all necessary address corrections (see pg. 2 para. 7 lines 4-6 and para. 8). In addition, the powerful software will also standardize your addresses and add ZIP+4 Codes to your address file. The NCOA COA file is updated weekly so your records are always as current and accurate as possible (see para. 7 lines 4-10 and para. 8). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Allen to include the teachings of Anchor in order to provide a marketer with greater flexibility in identifying a probable move, as taught in Anchor pg. 3 para. 4 lines 1-2.

It's noted that Senders, such as business mailers, wishing to receive notifications about undeliverable and corrected delivery addresses may participate in a special program, such as an Address Change Service ("ACS") program. Each ACS program participant may receive updated delivery address information for its customers. For example, when a business mailer (an ACS program participant) attempts to send an item, such as a mailpiece, to a customer who has relocated, a carrier, such as the U.S. Postal Service.TM., may provide the business mailer with a new delivery address. In addition, if requested, the U.S. Postal Service.TM. may forward that

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mailpiece to the customer's new delivery address. Receipt of an updated delivery address may allow a business mailer to update its own database so that a correct delivery address may be used in the future.

Regarding claims 15-17 and 39-41, It is well known in the field to track mail delivery through the postal system using mail sorters and scanners installed at large direct mail advertisers, their agencies and the postal service itself. Envelopes are printed with a machine-readable PLANET code that looks much like a bar-code. The limitations of the PLANET code system are tremendous. The codes cannot measure or report consumer's activity with the a piece of mail. The codes simply say where the mail is in the system until the mail leaves the post office. It does not carry through to the recipient (See Figs. 2-3 of Allen et al. US#5,422,821).

Regarding claims 18-19 and 42-43, Allen further teaches wherein the item delivery system comprises the United States Postal Service (see Col. 5 lines 39-53). Although, Allen discloses a delivery system as set forth above; Examiner notes the recitation; wherein the item delivery system comprises the United States Postal Service constitutes intended use language and as such is afforded little patentable weight. Furthermore, the recitation, "a United States Postal Service Priority Mail package, a United States Postal Service Express Mail Package, a United States Postal Service Global Express Mail Package, and a United States Postal Service Global Express Guarantee Package" is merely a statement of intended use and as such is afforded little patentable weight.

Regarding claims 23-24 and 47-48, Allen further teaches wherein at least one of the component for receiving and providing further comprises utilizing at least one of regular mail, e-mail, facsimile, internet, and an interactive voice response system (see Col. 4 lines 23-40), and



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further comprises communicating over a network (see Col. 4 lines 62-67, Examiner is interpreting a computer retrieval of information in a database as communication over a network).

With respect to claims 1-12, they are method claims corresponding to the apparatus and system claims 13-24 and 37-48 as discussed in paragraph above. Therefore, claims 1-12 are analyzed and rejected as previously discussed with respect to claims 13-24 and 37-48.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Lorch et al. (US#2007/0088749) is cited to show the registration based mail addressing system.

The Sansone (US#6,549,892) is cited to show the system for delivering mail.

The Esposito (US#6,101,496) is cited to show the ordered information geocoding method and apparatus.

The Jatkowski (US#6,457,012) is cited to show the method and system of updating address records utilizing a clientserver interface.

The sanders (US#6,711,555) is cited to show the method and apparatus for delivering mail items to non-postal route locations.

The Beaudoin et al. (US#6,400,715) is cited to show the network address matching circuit and method.

The Garner et al. (US#7,031,959) is cited to show the address matching.



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The Payne et al. (US#2004/01333443) cited how the method and apparatus for resolving an un-coded address.

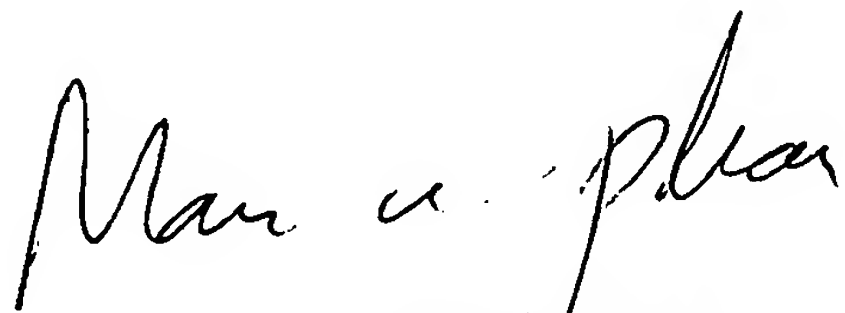
The Boyce et al. (US#2005/0251285) is cited to show a method and system for forwarding an item.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.



MAN U. PHAN  
PRIMARY EXAMINER